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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/688,188 | 10/17/2003 | Amer Hadba | 016295.1435 (DC-04713A) | 6652 |
| 7590 | 08/19/2005 | | EXAMINER | |
| Roger Fulghum Baker Botts L.L.P. One Shell Plaza 910 Louisiana Street Houston, TX 77002-4995 | | | PEYTON, TAMMARA R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2182 | |
| DATE MAILED: 08/19/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,188

Applicant(s)

HADBA ET AL

Examiner

Tammara R. Peyton

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/404,264. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a second connector having a plurality of connector pins, wherein the SATA connector has a number of connector pins which are less than the number of pins of the second connector and wherein the second connector provides a first and second SATA channel and a coupling unit for coupling the first and the second connector, wherein the coupling that comprises a multiplexer unit for establishing a coupling of one of the SATA channels with the SATA drive or for establishing a loop back function by coupling the first and second SATA channel.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7 recites the limitation "*the first connector*". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4-7, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy (US 2004/0162926) and Resnick (US 6,845,420).

As per claims 1, 5, 6, 7, and 14, Levy teaches a coupling device for a SATA drive having a SATA connector, wherein a second connector having a plurality of connector pins and the second connector provides a first and second SATA channel. Levy further teaches a coupling unit (3) for coupling the SATA connector and the second connector,

wherein the coupling unit comprises a multiplexer unit for establishing a coupling of one of the SATA channels with the SATA drive. (Levy, [0019-0040] However, Levy does not teach wherein the SATA connector has less pins than the second connector.

Nonetheless, Resnick teaches a docking station with a SATA connector 26 that is connected to an external storage device (i.e. SATA drive) wherein the SATA connector may include a buffer circuit for interfacing with a parallel interface connector (24).

Resnick teaches using common pins for interfacing between the SATA connector and the parallel interface connector. It is well known in the art that a parallel ATA connector has more pins than an SATA connector. (Resnick, [0012-0025]) It would have been obvious to one of ordinary skill that Levy would have been motivated to implement the interface connector of Resnick that allows for an external serial storage device (i.e. SATA drive) to be connected via a SATA connector through an interface connector with a different pin structure by using common pins for the interaction because doing so would allow for greater flexibility for connecting SATA drives and allow for reduce manufacturing costs for such an interface connector.

As per claims 4 and 12, Levy teaches wherein the coupling unit receives control signals from the second to either couple a first or second SATA channel with the SATA drive.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bicknell et al., (US 2003/0193776) and Wu (6,743,054).

Bicknell discloses a coupling device for a hard drive 106 comprising a first and a second connector having a plurality of connector pins, wherein the second connector provides a first and second SATA channel and a coupling unit for coupling the first and the second connector, wherein the coupling that comprises a multiplexer unit (208) for establishing a coupling of one of the SATA channels with the SATA drive or for establishing a loop back function by coupling the first and second SATA channel.

[Bicknell, 0030] Furthermore, Bicknell discloses that the communications of data, control signals, and/or power are established between components when all the connections between the connectors are made. However, Bicknell does not disclose the first and second connectors having a plurality of connector pins wherein the number of the connector pins of the first connector being less than the number of the second connector pins.

Wu discloses a coupling device 20 comprising a first connector 24 being SATA connector and having 22 pins, and a second connector 26 having 40 pins. The coupling device of Wu provides an electrical connection between two devices having different interface connections.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the coupling device taught by Bicknell such that it would have a first connector and a second connector having different number of pins as taught by Wu because a connector having a desired number of pins would be

required depending on a connector interface of a device that the connector is trying to make electrical connection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Popovici Dov can be reached on (571) 272-4083. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231.

Faxes for Official/formal (After Final) communications or for informal or draft communications (please label "PROPOSED" or "DRAFT") sent to:

(571) 273-8300

Hand-delivered responses should be brought to:

USTPO, Randolph Building, Customer Service Window
401 Dulany Street
Alexandria, VA 22314

Tammara Peyton
August 16, 2005

TAMMARA PEYTON
PRIMARY EXAMINER

